

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

AMERICAN PATENTS LLC,

Plaintiff,

v.

LEGRAND SA D/B/A/ LEGRAND,
SHANGHAI LEGRAND ELECTRICAL
CO. LTD., AND LEGRAND NORTH
AMERICA, LLC,

Defendants.

CIVIL ACTION NO. 6:21-cv-1333

JURY TRIAL DEMANDED

**JOINT MOTION TO DISMISS DEFENDANTS LEGRAND SA, SHANGHAI LEGRAND
ELECTRICAL CO. LTD WITHOUT PREJUDICE**

WHEREAS for the limited purpose of this case, in consideration of the mutual agreements between the parties, the parties agree as follows:

WHEREAS Defendants Legrand SA d/b/a Legrand, Shanghai Legrand Electrical Co. Ltd., and Legrand North America, LLC, represent and warrant to Plaintiff American Patents LLC as follows:

1. Defendant Legrand SA represents and warrants that it does not make, sell, or import the identified accused products in the complaint filed in this case.

2. Defendant Shanghai Legrand Electrical Co. Ltd. represents and warrants that it does not make, sell, or import the identified accused products in the complaint filed in this case.

3. Defendant Legrand North America, LLC is the only named Legrand entity that makes, sells, or imports the identified accused products in the complaint filed in this case.

4. Legrand North America, LLC can satisfy any adverse judgment in this action.

5. Legrand North America, LLC agrees that, for the limited purpose of this case, in return for the mutual promises of the parties herein, any documents or things that may be relevant to this action and that are in the possession, custody, or control of Shanghai Legrand Electrical Co. Ltd. or Legrand SA will be deemed to also be in the possession, custody, or control of Legrand North America, LLC. Likewise, Legrand North America, LLC agrees that it will not refuse to provide discovery on the grounds that Shanghai Legrand Electrical Co. Ltd. or Legrand SA is in possession, custody, or control of such discovery; however, Shanghai Legrand Electrical Co. Ltd. and Legrand SA should not have any relevant documents.

6. Shanghai Legrand Electrical Co. Ltd. and Legrand SA will not file any declaratory judgment action against American Patents LLC relating to the patents-in-suit as long as American Patents LLC does not seek to reinstate any claims against Shanghai Legrand Electrical Co. Ltd. or Legrand SA relating to the patents-in-suit.

7. Legrand North America, LLC will not assert that there is improper venue in this litigation.

8. Shanghai Legrand Electrical Co. Ltd. and Legrand SA agree that if American Patents LLC agrees to dismiss them without prejudice pursuant to Federal Rule of Civil Procedure 41(a)(1), such dismissal is made in reliance on Shanghai Legrand Electrical Co. Ltd., Legrand SA and Legrand North America, LLC's representations, warranties, and agreements described herein.

THEREFORE, Shanghai Legrand Electrical Co. Ltd., Legrand SA, Legrand North America, LLC, and American Patents LLC jointly move that Shanghai Legrand Electrical Co. Ltd.

and Legrand SA be dismissed without prejudice from this action, with all parties bearing their own costs and fees.

Dated: May 2, 2022

Respectfully submitted,

/s/ Zachariah S. Harrington

Matthew J. Antonelli

Texas Bar No. 24068432

matt@ahtlawfirm.com

Zachariah S. Harrington

Texas Bar No. 24057886

zac@ahtlawfirm.com

Larry D. Thompson, Jr.

Texas Bar No. 24051428

larry@ahtlawfirm.com

Christopher Ryan Pinckney

Texas Bar No. 24067819

ryan@ahtlawfirm.com

ANTONELLI, HARRINGTON

& THOMPSON LLP

4306 Yoakum Blvd., Ste. 450

Houston, TX 77006

(713) 581-3000

Attorneys for American Patents, LLC

Dated: May 2, 2022

Respectfully submitted,

/s/ Ahtoosa Dale

Kelly C. Hunsaker (*pro hac vice* pending)

Winston & Strawn LLP

275 Middlefield Road, Suite 205

Menlo Park, CA 94025

Tel. (650) 858-6500

Fax (650) 858-6559

KHunsaker@winston.com

Jeanifer Parsigian (*pro hac vice* pending)

JParsigian@winston.com

Yarden Z. Kakon (*pro hac vice* pending)

YKakon@winston.com
Winston & Strawn LLP
101 California Street, 34th Floor
San Francisco, CA 94111
Telephone: (415) 591-1000
Facsimile: (415) 591-1400

Ahtoosa Dale
TX State Bar Number 2410144
ADale@winston.com
Winston & Strawn LLP
2121 N. Pearl Street, Suite 900,
Dallas, TX 75201
Telephone: (214) 453-6500
Facsimile: (214) 453-6400

Matthew Hopkins (*pro hac vice* pending)
MHopkins@winston.com
Winston & Strawn LLP
1901 L Street, N.W.
Washington, D.C. 20036-3506
Telephone: (202) 282-5000
Facsimile: (202) 282-5100

CERTIFICATE OF SERVICE

I hereby certify that, on May 2, 2022, the foregoing document was electronically filed with the Clerk of Court using the Court's CM/ECF system which will send notification of such filing to all counsel of record.

/s/ Zachariah S. Harrington

Zachariah S. Harrington